

REMARKS

Applicants respectfully request reconsideration of the instant application in view of the preceding amendments and/or the following remarks. By this Amendment/Response, claims 24-26, 71-74, 81-97 and 99 have been withdrawn in accordance with the March 18, 2008 Restriction Requirement and new claims 100 and 101 have been added. Applicants submit that support for the new claims may be found throughout the originally filed specification, drawings and claims and that no new matter has been added by way of this Amendment/Response. Claims 18, 19, 27-29, 60-69, 75-80, 98, 100 and 101 are currently pending, with claims 24-26, 71-74, 81-97 and 99 withdrawn.

Claim Rejections - 35 U.S.C. § 101

Claims 29, 63, 69 and 80 have been rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse these rejections and submit that the claims are directed to statutory subject matter.

The November 25, 2008 Office Action alleges, "Claims 29, 63, 69, 80 recite a process comprising the steps of receiving, receiving and calculating. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing." (November 25, 2008 Office Action, p. 2, § 3). Applicants respectfully traverse this argument and submit that none of claims 29, 63 and 69 are directed to processes, as alleged in the pending rejection. Instead, claim 29 recites, *inter alia*, "A computer-readable medium encoded with processing instructions for implementing a method, performed by a computer" claim 63 recites, *inter alia*, "An apparatus for determining an insurance premium," and claim 69 recites, *inter alia*, "A computer-readable medium encoded

with processing instructions for implementing a method." Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to why the Examiner believes claims 29, 63 and 69 "recite a process," as alleged in the November 25, 2008 Office Action.

Independent claim 80 recites, *inter alia*, "A method of using a computer system to determine an insurance premium." Accordingly, Applicants submit that independent claim 80 positively recites another statutory class to which it is tied, and therefore respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to why the Examiner believes independent claim 80 is allegedly directed to non-statutory subject matter.

Claim Rejections - 35 U.S.C. § 103

Claims 18-19, 27-29, 60-69, 75-80 and 98 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osborn et al., U.S. Patent no. 6,182,048 (hereinafter, "Osborn") in view of Thomson et al., U.S. Patent Application no. 2003/0061104 (hereinafter, "Thomson"). Applicants respectfully traverse these rejections and submit that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each pending claim.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that, by applying a reference that the Examiner has not shown qualifies as prior art and by over-generalizing the applied references, the rejections in the November 25, 2008 Office Action do not establish at least either of the first two elements of a *prima facie* case of obviousness.

MPEP § 2141.01 (I) prescribes that, "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." Applicants submit that the Examiner has now made a *prima facie* showing that Thomson qualifies as prior art with respect to the instant application under any of the statutory categories of 35 U.S.C. § 102. The instant application has a filing date of August 23, 2000, while Thomson has a publication date of March 27, 2003 and a filing date of March 14, 2001. The pending rejection has, thus, attempted to cite a patent application (Thomson) as prior art against the pending claims in an earlier filed patent application. Furthermore, though Thomson is a continuation-in-part of application serial no. 09/526,353, which was filed on March 16, 2000, Applicants submit that there is no statutory category under 35 U.S.C. § 102 that makes a reference prior art as of its priority date. Applicants also note that Thomson is a continuation-in-part of the prior-filed application, and there is no evidence or indication provided by the Examiner as to whether the cited portions of Thomson even exist in the parent application. Accordingly, for at least these reasons, Applicants submit that the Examiner has now made a *prima facie* showing that Thomson qualifies as prior art and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request specific clarification on the record as to which section of 35

U.S.C. § 102 the Examiner believes Thomson allegedly qualifies as prior art under with respect to the instant application.

Even, *in arguendo*, if Thomson did qualify as prior art, Applicants submit that the pending rejection still fails to put forth a *prima facie* showing of obviousness. Independent claim 18 recites, *inter alia*,

18. A method for using a computer system to provide an insurance policy relating to a sale or lease of an item, comprising:

... charging a premium for the insurance to the third party

....

Applicants submit that the applied references, taken alone or in combination, do not discuss or render obvious at least these elements of independent claim 18. Though the pending rejection acknowledges "Osborn does not explicitly disclose ... charging a premium for the insurance to the third party," (November 25, 2008 Office Action, p. 3, § 5), the pending rejection goes on to allege, "Thompson [sic] suggests that the method having ...charging a premium for the insurance policy to the third party (See Thompson, Page 6, Paragraphs 0086-0092)." (November 25, 2008 Office Action, pp. 3-4, § 5).

Applicants respectfully traverse this rejection and submit that Thomson does not discuss or render obvious at least these claim elements. Thomson is directed to "an electronic warranty administration system that interfaces between customers and sellers and/or manufacturers" (Thomson, ¶ 0016). That is, Thomson's system is essentially a warranty middleman, intermediating between "[a] first database ... [that] contains personalized information about warranties held by a purchaser" and "a second database ... [that] contains warranty support information provided by multiple sellers" (Thomson, ¶ 0003). Applicants are entirely unclear as to which part of Thomson the Examiner believes allegedly discusses or renders obvious "charging a premium for the insurance policy to a third party," as recited in

independent claim 18. The pending rejection has cited ¶ 0086-0092 of Thomson as allegedly discussing the claim element, however the citation discusses numerous varied functions of Thomson's system, including revenue generation (¶ 0086), claims processing (¶ 0087), a help function (¶ 0088), shipping coordination (¶ 0089), consulting services (¶ 0090), linking to manufacturer help services (¶ 0091), and upgrade notifications (¶ 0092). MPEP § 707 prescribes, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable," and that "[t]he pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Applicants submit that, by citing to seven paragraphs discussing such a wide variety of apparently irrelevant functions of Thomson's system, the pending rejection has not designated "the particular part relied on," as required by MPEP § 707. The only part of the citation that is even apparently related to insurance occurs in ¶ 0090, however the insurance there is charged to the beneficiary (e.g., "offer the purchaser insurance," and, "[i]nsurance may also be offered to manufacturers to defray the cost of providing warranty repairs," Thomson, ¶ 0090). The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Applicants submit that the pending rejection has failed to consider "[all] words in [the] claim" in judging the patentability of the claim against the prior art, and that Thomson fails to discuss or render obvious, "charging a premium for the insurance policy to the third party," as recited in independent claim 18. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that he copy specific quotations from Thomson that he believes allegedly discuss the claimed "charging a premium for the

insurance policy to the third party," and clearly explain which player in Thomson's system is the insurance policy beneficiary and which is the third party to which the insurance premium is being charged so that Applicants can better understand the Examiner's rejection and formulate an effective response.

Applicants further note that independent claim 19 recites, *inter alia*,

19. A method for using a computer system to determine an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items;

...

Applicants submit that the applied references, taken alone or in combination, do not discuss or render obvious at least these elements of independent claim 19. Though the pending rejection acknowledges "Osborn does not explicitly disclose receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items," (November 25, 2008 Office Action, p. 4, § 5), the pending rejection goes on to allege, "Thompson [sic] suggests that the method having receiving from a manufacturer (See Thompson, Page 2, Paragraph 0015)." (November 25, 2008 Office Action, pp. 5, § 5). Applicants respectfully traverse this rejection and submit that Thomson's warranty middleman system does not include "receiving, from a manufacturer, an indication of a class of items," as recited in independent claim 19. The cited portion of Thomson, ¶ 0015, describes allowing customers to purchase extended warranties for purchased products from third party warranty administrators, and the centralization of warranty administration provided by Thomson's system. Applicants are entirely unclear as to which part of ¶ 0015 the Examiner believes allegedly discusses "receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items," as recited in

independent claim 19. MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." As neither Thomson nor Osborn, taken alone or in combination, discuss or render obvious at least "receiving, from a manufacturer, a indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items," as recited in independent claim 19, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that he copy specific quotations from Thomson, specifically indicating which parts of Thomson he believes discuss "a manufacturer," "a class of items," and "receiving, from a manufacturer, a indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items," as recited in independent claim 19.

Furthermore, Applicants submit that the pending rejection has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by failing to provide sufficient objective rationale for modifying the references and by not providing a discussion of the level of ordinary skill in the art.

Applicants submit that the Examiner has not provided sufficient objective rationale for combining the applied references. By way of example only, Applicants note that the pending rejection alleges, "It would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the features of Thompson [sic] within the system of Osborn with the motivation of providing an electronic warranty administration system that interfaces between customers and sellers and/or manufacturers (See Thompson [sic], Page 2, Paragraph 0016)." (November 25, 2008 Office Action, p. 4, § 5). Applicants respectfully submit

that the alleged rationales for the proposed modification of the applied reference are overly general and comprise no more than stated goals of Thomson's system which, in and of themselves, do not point beyond the reference to a modification or combination with Osborn. Applicants are unclear as to how the Examiner the stated goal of Thomson's system, "to provide an electronic warranty administration system that interfaces between customers and sellers and/or manufacturers" (Thomson, ¶ 0016), allegedly render the modifications of Thomson and Osborn obvious. The mere existence of an alleged utility of one of the applied references does not, by itself, constitute a rationale for changing the system described by that reference. MPEP §2141 (III) states, *inter alia*, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and that, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Applicants submit that, by merely quoting an alleged rationale of one of the applied references, the pending rejection has failed to provide a "clear articulation of the reason(s)" or an "articulated reasoning with some rational underpinning" for the proposed modifications of the references. Therefore, Applicants submit a *prima facie* showing of obviousness has not been made and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request precise clarification as to how the Examiner believes providing " an electronic warranty administration system that interfaces between customers and sellers and/or manufacturers" allegedly points to the specific modifications of the applied references that are proposed in the pending rejection and exactly why the Examiner believes the specific modifications would allegedly be in the capacity of one of ordinary skill in the art based on those cited portions of Thomson.

Applicants also submit that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to, "one of ordinary skill in the art," (e.g., November 25, 2008 Office Action, p. 4, § 5) but has provided no indication or discussion of which art is described or the level of ordinary skill alleged to be associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicants submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants submit that a *prima facie* showing of obviousness has not been made and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that he discuss the level of ordinary skill in the art at the time of the invention and clarify how and specifically why he believes the claimed subject matter would have been obvious to one possessing that level of skill.

Although of different scope than claims 18 and 19, Applicants submit that claim 27 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19. For example, claim 27 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

means for receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items;

...

Applicants respectfully submit that at least these claim elements from independent claim 27 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 28 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 28 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

receive, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items;

...

Applicants respectfully submit that at least these claim elements from independent claim 28 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 29 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 29 recites, *inter alia*:

A computer-readable medium encoded with processing instructions for implementing a method, performed by a computer,

for determining an insurance premium to be charged to a party providing insurance to a buyer of an item, the method comprising:

receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items;

...

Applicants respectfully submit that at least these claim elements from independent claim 29 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 60 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 60 recites, *inter alia*:

A method operable on a computer for providing an insurance policy relating to a sale or lease of an item, comprising:

...

charging a premium for the insurance policy to the third party, the premium based on characteristics of the class of the item, expected demographics of the buyer or lessee of the item and a geographic region of the buyer or lessee, without consideration of individual qualifications of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 60 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 61 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above

identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 61 recites, *inter alia*:

A method operable on a computer for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:
receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer or lessee of one of the class of items;
...

Applicants respectfully submit that at least these claim elements from independent claim 61 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 62 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 62 recites, *inter alia*:

A method operable on a computer for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:
...
calculating on the computer a premium to be charged for an insurance policy issued to the buyer or lessee, the premium being based on the characteristics of the class of items, anticipated demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 62 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in

combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 63 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 63 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

...;

means for calculating a premium to be charged for an insurance policy issued to the buyer or lessee, the premium being based on the characteristics of the class of items, anticipated demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 63 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 64 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 64 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

...;

calculate a premium to be charged for each insurance policy issued to the buyer or lessee, the premium being based on characteristics of the class of items, anticipated demographics of the

buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 64 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 65 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 65 recites, *inter alia*:

A computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, the method comprising:

...;

calculating a premium to be charged for each insurance policy issued to the buyer or lessee, the premium being based on characteristics of the class of items, expected demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 65 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 66 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above

identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 66 recites, *inter alia*:

A method operable on a computer for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

...;

calculating, on the computer, a premium to be charged for each insurance policy issued to the buyer or lessee in the geographic region, the premium being based on characteristics of the class of items, expected demographics of the buyer or lessee, and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 66 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 67 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 67 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

...;

means for calculating a premium to be charged for each insurance policy issued to the buyer or lessee in the geographic region, the premium being based on characteristics of the class of items, expected demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 67 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in

combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 68 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 68 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of an item, comprising:

...;

calculate a premium to be charged for each insurance policy issued to the buyer or lessee in the geographic region, the premium being based on characteristics of the class of items, expected demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 68 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 69 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 69 recites, *inter alia*:

A computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for determining an insurance premium to be charged to a party providing insurance to a lessee of an item, the method comprising::

...;

calculating a premium to be charged for each insurance policy issued to the lessee, the premium being based on characteristics of the class of items, expected demographics of the

buyer or lessee and the geographic region, without consideration of individual characteristics of the lessee.

Applicants respectfully submit that at least these claim elements from independent claim 69 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 75 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 75 recites, *inter alia*:

An apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer or lessee of a motor vehicle, comprising:

...;

calculate a premium to be charged for an insurance policy issued to the buyer or lessee in the geographic region, the premium being based on characteristics of the model of motor vehicle, expected demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 75 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 80 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 80 recites, *inter alia*:

A method of using a computer system to determine an insurance premium to be charged to a party providing insurance to a buyer or lessee of a motor vehicle, comprising:

...;

calculating a premium to be charged for an insurance policy issued to the buyer or lessee in the geographic region, the premium being based on characteristics of the model of motor vehicle, expected demographics of the buyer or lessee and the geographic region, without consideration of individual characteristics of the buyer or lessee.

Applicants respectfully submit that at least these claim elements from independent claim 80 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claims 18 and 19, Applicants submit that claim 98 is patentable over Osborn in view of Thomson for at least similar reasons as discussed above identifying deficiencies in Osborn and Thomson with regard to independent claims 18 and 19.

For example, claim 98 recites, *inter alia*:

A method for using a computer system to provide an insurance policy relating to a sale or lease of an item, comprising:

...

charging a premium for the insurance policy to the third party, the premium is determined based on a class of the item and a geographic region of the buyer or lessee without consideration of individual characteristics of the buyer or lessee to determine whether the buyer qualifies for the insurance policy.

Applicants respectfully submit that at least these claim elements from independent claim 98 are not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicants submit claims 76-79, which are directly or indirectly dependent from independent claim 75, are also not discussed or rendered obvious by Osborn, which describes risk-based pricing of vehicle warranties, or Thomson, which describes a warranty middleman service, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claim elements, there was/is no reason, rationale or motivation (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)) for such a combination of references, and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 18, 19, 27-29, 60-69, 75-80, 98, 100 and 101 all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed here or in previous amendments/responses, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying

to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized and requested to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17246-004. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17246-004.

Respectfully submitted,
Chadbourne & Parke LLP

Dated: May 26, 2009

By: /Walter G. Hanchuk/

Walter G. Hanchuk
Registration No. 35,179

Chadbourne & Parke, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile